

REMARKS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1, 3-5, 7-10, 13-17, and 20-29 are presently active in this case. Claims 2, 5, 6, 11, 12, 18 and 19 are canceled by way of the present Amendment. New Claims 21-29 are added by way of the present Amendment. New Claims 22-23 recite limitations from original Claim 1 in dependent form; new Claims 24 and 25 recite limitations from Claim 8 in dependent form; new Claims 26 and 27 recite the limitations of Claim 21 in dependent form; and new Claims 28 and 29 recite the limitations of Claim 21 in dependent form.

In the outstanding Office Action, the specification was objected to because of informalities. Claims 1, 2, 5, 6, 8, 11-14, 16, 18-20 are rejected under 35 U.S.C. §102(a) as anticipated by Kowtha from the IEEE Proceedings on the ATM workshop, May 1999 (hereinafter "Kowtha"). Claims 3, 7 and 9 are rejected under 35 U.S.C. §103(a) as unpatentable over Kowtha in view of Li et al. (U.S. Patent No. 6,195,714, hereinafter "Li"). Claims 4, 10, 15 and 17 were rejected under 35 U.S.C. §103(a) as unpatentable over Kowtha in view of Civanlar et al. (U.S. Patent No. 6,339,594, hereinafter "Civanlar").

First, Applicants wish to thank Supervisory Examiner Kizou and Examiner Swickhamer for the courtesy of an interview granted to Applicants' representative on June 18, 2003, at which time the outstanding issues in this case were discussed. Applicants further thank Examiner Swickhamer for two

follow-up telephone discussions. Arguments similar to the ones developed hereinafter were presented and the Examiners indicated that in light of the arguments, they will review the Kowtha reference to confirm non-anticipation and update their search.

In response to the objection to the specification, the drawings have been amended to correct the noted informality. In particular, Fig. 4 has been relabeled as Fig. 5 and Fig. 5 has been relabeled as Fig. 4. In light of their informal nature, the changes to the drawings are not believed to raise a question of new matter. Upon receiving approval for the requested drawing changes, and upon receiving a formal Notice of Allowance, prior to payment of the base issue fee, Applicant will file formal drawings included with the requested drawing changes.

In response to the rejections of the claims under 35 U.S.C. §102(a) and 35 U.S.C. §103(a), Applicants have amended claims 1, 13 and 20 to overcome the outstanding rejections and added new claim 21.

Applicants have amended independent claims 1, 8, 13 and 20 to recite an "IP backbone network" to further clarify the invention. The Kowtha reference *explicitly* teaches an "ATM based network."¹ Thus, the Kowtha reference fails to teach an "IP backbone network." In view of the above, the cited prior art fails to teach or suggest every feature recited in Applicants' claims so that Claims 1, 3-5, 7-10, 13-17, and 20-29 are believed to be patentably distinguishable over the cited prior art. Accordingly, Applicants

¹ See the Kowtha reference at page 202, Fig. 1.

respectfully traverse and request reconsideration of, the rejections based the Kowtha reference.²

New Claim 21 has been added which recites "wherein said source gateway transmits an IP signaling message to said controller upon receipt of an ATM signaling message; and wherein the ATM signaling message is an ATM UNI signaling message that follows the H.323 protocol."³ In light of these amendments, claims 1, 13 and 20 are no longer believed to be anticipated by the Kowtha reference. As such, claims 1, 3-5, 7-10, 13-17, and 20-29, in light of their dependencies, are believed to be patentably distinguishable over the cited prior art.

The present amendment is submitted in accordance with the provisions of 37 CFR 1.116, which after final rejection permits entry of amendments placing the claims in better form for consideration on appeal. As the present amendment is believed to overcome the outstanding rejections under 35 U.S.C. §102(a) and 35 U.S.C. §103(a), the present amendment placed the application in better form for consideration on appeal. In addition, the present amendment is not believed to raise new issues since the changes to claims 1, 8, 13 and 20 merely recite limitations previously introduced in claims 2 and 3, and the changes to the drawings are of a minor nature. Further, new Claims 21-29 merely recite previously introduced subject matter. It is therefore respectfully

² See M.P.E.P. §2121: "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," (citations omitted) (emphasis added). See also M.P.E.P. §2143.03: "all words in a claim must be considered in judging the patentability of that claim against the prior art."

³ New claim 21 and those that depend therefrom include the limitations of originally filed claims 1-4.

requested that 37 CFR 1.116 be liberally construed, and that the present amendment be entered.

CONCLUSION

In view of above remarks, reconsideration of the outstanding rejection and allowance of pending claims 1, 3-5, 7-10, 13-17, and 20-29 is respectfully requested.

If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Timothy J. Maier, Reg. No. 51,986, at the number listed below.

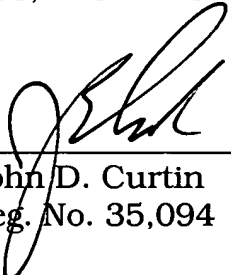
Pursuant to 37 C.F.R. 1.17 and 1.136(a), the Applicants respectfully petition for a one (1) month extension of time for filing a response in connection with the present application, and the required fee of \$110.00 is attached.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Very truly yours,

HARNESS, DICKEY & PIERCE, PLC

By


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